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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,373	01/14/2004	Robert Stieper Milligan	57282.2	2361
27128 7590 11/23/2009 HUSCH BLACKWELL SANDERS LLP 190 Carondelet Plaza Suite 600 ST. LOUIS, MO 63105				
EXAMINER				
SAYALA, CHHAYA D				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
11/23/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto-sl@huschblackwell.com

Office Action Summary**Application No.**

10/756,373

Applicant(s)

MILLIGAN, ROBERT STIEPER

Examiner

C. SAYALA

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Reopening of Prosecution After Appeal

In view of the appeal brief filed on 10/22/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below (see end of action).

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-4, 6, 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "at least one carrying agent" to be "a copolymer and powdered vegetable starch". It is not clear if applicant intends the "copolymer and powdered vegetable starch" to be one unit, i.e. one carrying agent or that the at least one carrying agent be selected from the copolymer and powdered vegetable starch.

Claim 1 recites an injection molded composition that comprises an animal product and a carrying agent, wherein the animal product has a particle size of between about 300 and about 1000 microns and a moisture content less than about 20 wt%. The preamble suggests a final "injection molded" product and yet the animal product described with its micron size and moisture content relates to the ingredient before being injection-molded. Clarification is necessary to properly define the product. For purposes of this examination, the claim is being treated as containing at least one carrying agent selected from copolymer and vegetable starch.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US Patent 6455083) in view of Axelrod (US Patent 5240720) and further in view of Gluck (US Patent 6228418).

Wang teaches an injection molded composition that contains meat, beef meat, pork meat, dried meat floss or a combination in an amount 0.5 to 15 wt% which falls within the scope of the amount of meat-based ingredient of applicant's claims. See col. 3, lines 34-40. The patent does not teach that the meat comes from offal, thigh, breast or organs, but it would have been obvious to have used any of these parts because applicant's list covers all the parts of an animal that can be used. Wang includes in its composition sweet potato starch and potato starch (col. 3, lines 3-4, col. 6, line 15) in an amount about 20 to 50 wt% and moisture in an amount about 8 to 20 wt% (col. 7, line 61). The patent also discloses the use of nutrients such as vitamins C and E in an amount of up to about 5 wt%. See claims 21-23.

The patent does not disclose cartilage or the particle size of the animal product.

With regard to particle size, Axelrod teaches an injection molded product that contains 47.5% of poultry meal and a total moisture content of 10-15 wt% (see claim 1). At examples 1 and 2, Axelrod teaches intermixing the ingredients before injection molding, and to achieve such, teaches screening the ingredients to 30 mesh (about 800

microns). Such disclosure shows that for a meat based injection molded product, grinding down the ingredients to obtain the disclosed particle size would have been obvious. Note that the teaching is for a meat-based injection molded product, the meat coming from poultry which would include duck, goose, turkey or chicken. Also it must be said that prior art is replete with injection molded pet food products using a variety of ingredients as evident from the references applied here.

With regard to cartilage, even though Wang teaches collagen in his product and collagen is derived from cartilage and cartilage is not disclosed, Gluck teaches a vegetable pet treat that includes cartilage powder in its formulation for its nutraceutical value. See col. 3, lines 46-47 and col. 6, line 56. Therefore, to incorporate such a nutraceutical in the Wang product which already discloses the use of other nutraceuticals in its formulation, would have been useful and prima facie obvious.

3. Claims 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US Patent 6455083) in view of Axelrod et al. (US Patent 6586027) and Chizmas (US Pub. 2002/0172752) and further in view of Axelrod (US Patents 5339771 and 5240720) taken with Axelrod (US Patent 6056991).

Wang is as described above. Wang discloses making an injection molded pet product that contains animal meat or poultry meat in an amount 0.5 to 15 wt% and potato or sweet potato starch in an amount 20 to 50 wt%. The patent does not include a copolymer in its formulation. Axelrod '027 teaches an injection molded product with starch up to about 50 wt% that also includes ethylene copolymers. See col. 5, line 53 to

col. 6, line 5 and claims 22, 24-25. Note that Axelrod incorporates the starches of his US Patent 6159516, which includes potato starch. Axelrod teaches that the composition may include animal meal. See col. 5, line 56.

Chizmas teaches an injection molded pet product that can contain pork, beef, lamb, rice, vegetable products as well as nutraceuticals such as cartilage. See ¶ [0012] to [0013]. Such disclosure establishes that prior art was already aware at the time the invention was made to manufacture by injection molding, any combination of starch, vegetable matter, animal meat, and copolymer. Based on this, therefore, it would have been obvious to one of ordinary skill in the art to combine vegetable starch and copolymer as well as animal meat and injection mold the combination to form a pet food product. With regard to the steps, Axelrod '771 and Axelrod '720, both drawn to injection molded products using animal meal, teach sifting the meal to remove particles greater than 30 mesh (about 800 microns) and mixing the screened or sifted meal with the synthetic polymer ('771, col. 2, example). Note that Chizmas teaches that the particle size will be dependent on obtaining a homogeneous dispersal of additives throughout the composition (¶ [0015]). The '771 and '720 patents then disclose the mixture being supplied to an injection molding machine where a temperature that includes up to about 390°F is used ('720). See col. 2, lines 60+ in '720 which teaches that the temperatures are increased under pressure and the final moisture of the product is adjusted by this increase of temperature and pressure. The composition is molded in pre-selected shapes, preferably a bone-shape. Even though Axelrod teaches the use of pressure, he does not specify the pressure used. Axelrod '991 shows the

pressure to be 1000 psi, the temperature being the same as claimed herein and the product combining turkey meat and starch. Therefore, to incorporate such a pressure would have been advantageous and would not have required any more than ordinary skill in the art.

With regard to the molding time, while no reference applied here teaches this aspect, it should be noted that based on just the references applied here, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the process of injection molding was practiced quite commonly with regard to pet chews, and therefore, to maintain a residency time that would have achieved the molded product as desired would have been within the ambit of ordinary skill, especially when Axelrod already provides guidance as to particle size, moisture content, temperatures and pressures to be used. Injection molding is a process common enough in the manufacture of pet food products to be almost known as a standard method of making these products as evidenced by the numerous prior art Axelrod patents. Axelrod's body of work shows that any combination of meat, vegetables, fruit, copolymer, starch and/or protein were being combined at the time the invention was made, which is also disclosed by Chizmas.

Claim Rejections - 35 USC § 102/ Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 20 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Axelrod (US Patent 5339771) or Axelrod et al. (US Patent 6586027).

Both patents are drawn to a product that is injection molded and that contains animal meal, starch, etc. as well as synthetic copolymers. Applicants' claim is written in product-by-process format and as such, it is the novelty of the instantly claimed product that need be established and not that of the recited process steps. *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Wertheim*, 191 USPQ (CCPA 1976). "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir.1985).

Response to Arguments

Applicant's arguments filed 10/22/2008 have been fully considered but they are not persuasive.

At page 9 of the Brief, applicant states that Wang's animal meal is used as a flavoring, while his animal meat is used as a base for pet food. While this may be true, animal meat/meal is still animal meat/meal and so long as the amount prescribed by the instant claims is met by or is included in the reference, then the reference is not only applicable but meets this limitation as claimed. Meat used as a flavor and meat used as a "physical and nutritional base" (Brief, p. 9, first full paragraph) is still the same and would provide either function or both functions, since the amount as claimed is included in the reference. Furthermore, meat and its properties are inseparable. Meat's flavoring property does not cease by its being used as a base and vice-versa. With regard to the discussion of Axelrod '027, since that reference has been withdrawn in the capacity in which it was applied, applicant arguments are deemed moot. However, applicant's discussion of "resin" in the Axelrod's work is disagreed with. Axelrod's use of "resin" represents a variety of ingredients, such as starch, collagen, copolymer etc. Furthermore, applicant (as in Axelrod) can be his own lexicographer. Therefore, applicant's reference to Webster's Dictionary is of no moment. When meat (in the same quantity, i.e. 10-15%) and copolymer and/or vegetable starch are injection molded, it is similar to Axelrod, if not the same.

Applicant's remarks that there is no motivation to make the combination of Axelrod '027 and Wang is irrelevant to the present rejection. However, with reference to the rejection that is now made, it would have been obvious by surveying Axelrod's work (and based on the Chizmas publication), that any combination of meat, collagen, starch, vegetable matter, copolymer, vitamins, minerals, herbs and even fruit were all

commonly made at the time the invention was made. Applicant's choice among these combinations is animal meat and copolymer.

At page 12 of his brief, applicant states that "powder" is referred to a particle size less than 300 microns. Such a statement is not based on any accompanying evidence. Attorney's arguments do not take the place of evidence. Even though this position by the applicant is deemed moot by the new grounds of rejection, without some factual evidence, applicant's categorical statement that all powders have a particle size less than 300 microns is weak and fails to establish that Wang's powder does not fall within the claimed micron size.

The declaration filed 10/15/2007:

With reference to the declaration of Milligan, which states that finding the particle size between about 300 and about 1200 microns for an injection molded dog treat is inventive and not routine experimentation, Axelrod shows chicken meal reduced to no greater than 30 mesh (about 800 microns) in '771 and casein and gelatin to 30 mesh in '720. It appears therefore, that Axelrod had already discovered that a particle size of about 800 microns to be beneficial to intimately mix together the ingredients of an injection molded dog treat to obtain a homogeneous distribution of ingredients so as to injection mold them together. The Axelrod patents, as now applied, also teach the temperature, moisture content, pressure etc. To adopt or even to adapt such parameters in a similar method would not have been "uniquely challenging".

With regard to the commercial success of the product and declarant's statement that he attributes this to the particular "inventive combination" (§ 12 of declaration) and the chunk size of the animal meat, applicant has not provided any evidence to establish that such a nexus exists. A mere statement is self-serving without the necessary accompanying evidence. As to § 8, which states that the tested dogs preferred meat-based treats having the claimed particle size, there are no results presented showing what other particle sizes were provided to the dogs. A mere statement is insufficient for the record in order to establish patentability over prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala, whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Art Unit: 1794

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. SAYALA/

Primary Examiner, Art Unit 1794

/Keith D. Hendricks/

Supervisory Patent Examiner, Art Unit 1794